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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

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TECHNOLOGY CENTER R3700

APPEAL NO.

2001-0790

Appellants: Daniel M. Eggert and Frank Mikic  
Title: MAGNETIC BIT HOLDER AND HAND TOOL  
INCORPORATING SAME  
Application No.: 09/110,145  
Examiner: D.S. Meislin

Attorney Docket No. 428192

**APPELLANTS' RESPONSE TO REQUEST FOR REHEARING**

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Irene Feizulov

The examiner has filed a Request for Rehearing (“Request”) of the decision by the Board of Patent Appeals and Interferences (“Board”) dated August 3, 3001 reversing the final rejection of reissue claims 15-22 under 35 U.S.C. §251. Appellants oppose the Request because the examiner has failed to show any error in the Board’s decision and, indeed, has failed to raise any relevant issue not already considered by the Board. Accordingly, the examiner has shown no justification for rehearing. Therefore, the Request should be denied or, if granted, the Board’s decision should be adhered to, since it is fully supported by the applicable authorities.

**I. Summary of Argument**

The essence of the examiner’s position is that appellants have failed to establish an “error without deceptive intent” in support of the reissue application, as required by 35 U.S.C. § 251. In particular, the examiner contends that where, as here, a limitation is added to a claim in order to obtain its allowance in the original patent, the submission in a reissue application of a claim which omits that limitation does not constitute “error” of the type contemplated by § 251, irrespective of other limitations in the reissue claim. However, that position has been considered and expressly repudiated by the Court of Appeals for the Federal Circuit (“CAFC”) in *Ball Corp. v. United States*, 221 USPQ 289 (Fed. Cir. 1984). The *Ball* case, which is the closest case factually to the present case, was relied on by the Board and has not been reversed or overruled.

The authorities cited by the examiner in support of her contention are all factually distinguishable from the present case, because none of them involved a situation wherein, as here, the appellants added a limitation with respect to the characteristics of a particular claim element to obtain allowance of that claim in the original patent and then, in reissue, presented a

claim omitting the limitation, but substituting in its place a different narrowing limitation with respect to other characteristics of the particular claim element.

Furthermore the relevant authorities relied on by the examiner, i.e., those relating to reissue, have already been expressly considered by the Board and/or have been considered by the CAFC in the *Ball* decision.

## **II. Argument**

### **A. The Examiner's Position Has Been Repudiated by the CAFC**

The examiner contends that the “recapture” rule should not be applied by analysis of claim scope, but rather should be applied to individual claim limitations. In particular, the examiner contends that, where an appellant is compelled by a rejection to narrow a claim by adding a limitation, the appellant may not, after the issuance of the patent, seek to broaden the claim by presenting in a reissue application a claim which omits the limitation which had been added in order to secure the patent (Request at 10), because this does not constitute an “error” of the type contemplated by 35 U.S.C. §251. The problem with the examiner’s contention is that it has been considered and explicitly rejected by the CAFC in *Ball*. In that case, the patentee had, in the face of a rejection, given up claims which would have covered a single feed line, and accepted claims which issued in the original patent and which were limited to a plurality of feed lines. Then, in reissue, the patentee sought claims which would again cover a single feed line, but which still distinguished from the prior art with respect to the feed means aspect. The government, relying on *Riley v. Broadway-Hale Stores, Inc.*, 103 USPQ 414, 415 (9<sup>th</sup> Cir. 1954), contended that the court should look at “the feature given up” by the patentee, i.e., a single feed

line, and hold that the attempt to obtain in reissue a claim which would cover a single feed line is improper. In upholding the reissue claims the CAFC stated that:

“We decline to adopt the rigid standard applied in *Riley*, in favor of the more liberal approach taken by the CCPA.” (221 USPQ at 294).

Repeatedly in the opinion, the Court stated that the proper focus is on the scope of the claims and not on the individual feature or element purportedly given up during prosecution of the original application (see, 221 USPQ at 294, 295). Thus, the court stated:

“The Government argues that that standard is not correct because it loses sight of the *feature* that the patentee gave up during prosecution of the original application. We find the Government’s argument entirely unpersuasive. The proper focus is on the *scope* of the claims, not on the individual *feature* or *element* purportedly given up during prosecution of the original application.” (Emphasis in original.) (221 USPQ at 295).

On the issue of whether or not the omission of a deliberately added claim element could constitute an “error” under §251, the court held that:

“While deliberate cancellation of a claim cannot ordinarily be considered error, the CCPA has repeatedly held that the deliberate cancellation of claims *may* constitute error, if it occurs without deceptive intent.” (Emphasis in original). (221 USPQ at 294).

There is no evidence whatsoever of deceptive intent in the present case.

The *Ball* decision has not been reversed or overruled and remains good law.

**B. The *Ball* Decision Is Controlling Authority**

The *Ball* case is virtually “on all fours” with the present case. In the original patent application, the appellant had sought claims which recited a feed means which includes “at least one conductive lead” and, therefore, covered a single feed line. Those claims were rejected and, ultimately, the appellant amended them to recite a plurality of feed lines, which claims were

allowed. Then, in reissue, the patentee identified as error the undue limitation of the patent claims to a plurality of feed lines and presented a claim reciting “a single electrical signal feed assembly...exciting both of said radiation slots from a single signal feed junction.” (221 USPQ at 292). The court noted that, as disclosed, the signal feed assembly is a network of leads with a single coaxial feed line to that network, and concluded that “[t]he signal feed assembly is more limited than the ‘at least one’ feed means limitation of canceled claim 8.” (221 USPQ at 295). Thus, the particular feed limitation added to obtain issuance of the patent was deleted in reissue, but was replaced with a different feed limitation which made the reissue claim narrower, as regards the feed aspect, than claims canceled in the original application, although broader than the original patent claims.\*

The present case presents the same type of scenario. The original application claims were silent as to the shape of the retaining member. In the face of a rejection, they were amended to add a requirement that the retaining member be “bowl-shaped,” after which the claims were allowed. In the reissue application, appellants have deleted the “bowl-shaped” limitation but have added other limitations relating to the shape of the retainer, which render the reissue claims narrower than the claims canceled in the original application, although broader than the patent claims, as to the aspect regarding shape of the retaining member. The reissue claims are broader than the canceled claims in certain other respects, none of which were material to patentability. The *Ball* decision clearly holds that, in this situation, the reissue claims are proper, do not

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\* The court noted that the reissue claims were broader than the canceled claims in another aspect, in that they were not limited to a cylindrical antenna configuration, but held that that limitation was not material to patentability.

involve “recapture” of any surrendered subject matter, and are based on an adequate “error” within the meaning of 35 U.S.C. §251. The *Ball* decision is directly on point, remains good law, and the examiner has offered no plausible reason why it should not be followed.

**C. The Authorities Relied on by the Examiner  
Are Factually Distinguishable from the  
Present Case**

Despite the fact that the *Ball* case explicitly rejected the notion that the “recapture” rule should be applied on a limitation-by-limitation basis, the examiner nevertheless attempts to show support for this discredited approach.

The key factual element in the present case, which the examiner apparently loses sight of, is that the independent reissue claims 15 and 22 did not simply eliminate the requirement that the retaining member have particular characteristics, but instead substituted for one characteristic-- “generally bowl-shaped” and “convex”-- another characteristic of the shape of the retaining member which was narrower than any claim which had been surrendered during the prosecution of the original patent. Thus, the resulting reissue claims are narrower, as to an aspect germane to the rejection, than any claim surrendered during prosecution of the original patent. That scenario is not presented in any of the cases relied on by the examiner.

The examiner first cites *Shepard v. Carrigan*, 116 U.S. 593 (1886). That case was an infringement suit and dealt with what is now referred to as the “prosecution history estoppel” limitation on the doctrine of equivalents. The case did not involve reissue patents at all, let alone the recapture issue. The patentee had been compelled to include a limitation in his claim in order to obtain issuance, and the court held that he could not, in asserting the patent claim against

another, attempt to read the claim as covering a device which did not include the very element he was compelled to add in order to secure the patent. The court did state in passing that, "Under the circumstances of this case the inventor could not even get a reissue based on the broader claim which she had abandoned." (116 U.S. at 598). However, this was clearly *dictum*. Even assuming that the *Shepard* case were legally relevant, it is factually distinguishable from the present case, since the patentee was simply attempting to disregard a claim limitation included to obtain the patent, without which limitation the resulting claim would clearly have been broader than the patent claim in an aspect germane to patentability and would not have been narrower in any aspect.

The examiner next cites *In re Byers*, 109 USPQ 53 (C.C.P. 1956) and the aforementioned *Riley* case. Both of these cases are factually distinguishable from the present case. In *Byers* the court found that:

"A comparison of the claims makes it clear that appealed claims 2 and 3 are drawn to the same invention as was original claim 20 of appellant's original application, and that they are broader in certain respects and **not narrower in any respect than that claim.**" (Emphasis added)(109 USPQ at 55).

Similarly, in *Riley*, the original patent claims were limited to shoulder pads with voids and the reissue claim eliminated the voids limitation without substituting any other. Thus, the reissue claim was broader in this respect and not narrower in any respect.

The examiner next cites *Hester Industries, Inc. v. Stein, Inc.*, 46 USPQ 2d 1641 (Fed. Cir. 1998). In that case, the reissue claim omitted a limitation which, while not added by amendment in the original patent, had been repeatedly relied on by the appellant to distinguish from the prior

art. Thus, the reissue claims were broader than the original patent claims in this respect.

However, again, the court held that:

“The asserted reissue claims are not materially narrower [than the patent claims] despite Hester’s arguments to the contrary.” (46 USPQ at 1650).

Next, the examiner cites *Mentor Corp. v. Coloplast, Inc.*, 27 USPQ 2d 1521 (Fed. Cir. 1993). In that case, the original patent claims included a limitation that adhesive “is transferred without rolling the catheter inside out,” which limitation was added to overcome a rejection. The reissue claim omitted that limitation and, thus, was broader, with respect to an aspect that was germane to the rejection. However, despite arguments by the patentee to the contrary, the Court again specifically held:

“Moreover, the added limitations do not narrow the claims in any material respect compared with their broadening.” (27 USPQ 2d at 1525).

The examiner next cites *Pannu v. Storz Instruments, Inc.*, 59 USPQ 2d 1597 (Fed. Cir. 2001). In this case the patentee had added, during prosecution of the original patent, a limitation relating to the shape of “haptics” in an intraocular lens. The reissue claim omitted that limitation, but added other limitations unrelated to the shape of the haptic. Thus, the reissue claim deleted the limitation which had been germane to the rejection during prosecution of the original patent, thereby making the claim broader in that respect, but narrowed the claim in aspects that were unrelated to that issue. In other words, it was the exact opposite of the present case, in which the reissue claim was narrowed in an aspect germane to the rejection, and broadened in aspects which were unrelated to patentability. The court held in *Pannu* that:



“The narrowing aspect of the claim on reissue, however, was not related to the shape of the haptics, but rather the positioning and dimensions of the snag resistant means. Therefore, the reissued claims were not narrowed in any material respect compared with their broadening.” (59 USPQ 2d at 1600-1601).

The examiner contends (Request at 20) that “For the Pannu court, it was enough that a limitation which was added to overcome a prior art rejection (in the prosecution leading to the patent) was omitted in the reissue patent.” As was explained above, that was **not** enough for the *Pannu* court. What was enough for the *Pannu* court was that the claim was broadened in an aspect related to patentability rather than being narrowed in that aspect.

The examiner also mentions *In re Clement*, 45 USPQ 2d 1161 (Fed. Cir. 1997). In discussing that case, at page 21 of the Request, the examiner contends that the present case falls in a category not considered by the *Clement* court, i.e., wherein the reissue claim is both broadened and narrowed in an aspect germane to a prior art rejection, and suggests that “The Board has apparently placed the present fact situation within this third possibility.” On the contrary, there is no indication that the Board has done any such thing. When the *Clement* court set forth its recapture analysis principles, it made clear that the analysis considers whether the reissue claim is broadened or narrowed as compared to “the canceled or amended claim” in the prosecution of the original patent (45 USPQ 2d at 1165). As the Board correctly points out, the aspect of appellants’ original patent claim which had been added to overcome the prior art rejection related to the shape of the retaining member. As to this aspect, there is simply no question that both of the independent reissue claims 15 and 22 are narrower, and not broader, than any claim which was canceled or amended during the prosecution of the original patent,

since those canceled and/or amended claims were silent as to the shape of the retaining member. What appellants have done in the reissue claims, is to remove from the patent claim a first specific limitation as to the shape of the retaining member and to substitute for it a second specific limitation as to the shape of the retaining member. The examiner's attempt to characterize the second limitation as a broadening flies in the face of the facts.

Finally, at page 22 of the Request, the examiner cites *Maxwell v. J. Baker, Inc.*, 39 USPQ 2d 1001 (Fed. Cir. 1996), which involved a patent disclosing two embodiments, but the patent claims were specific to only one. The patentee attempted to argue that the claims should be interpreted broadly enough to cover an allegedly infringing device, which used the second, unclaimed embodiment. The court held that the disclosed, but unclaimed second embodiment was dedicated to the public. The examiner cites the case in support of a contention that appellants herein should have filed a continuation application rather than a reissue application to pursue the reissue claims. But the examiner ignores the explicit statement by the court in *Maxwell* that:

“Of course, within two years from the grant of the original patent, a patentee may seek reissue of the patent and attempt to enlarge the scope of the claims to include the disclosed but previously unclaimed subject matter.” (39 USPQ 2d at 1006, n.2).

Furthermore, appellants herein could not have filed a continuation application, because the error was not discovered until after the patent issued.

In short, the examiner has cited no case which supports the position that it is improper to present in reissue a claim which omits a limitation added to the original patent claim to obtain its issuance, irrespective of any other limitation in the reissue claim.

**D.     The Authorities Relied on by the Examiner  
Have Been Fully Considered by the Board**

The examiner has not presented any relevant authority not already considered by the Board. The only decisions cited by the examiner which involve reissue are the *Ball*, *Mentor*, *Byers*, *Riley*, *Hester*, *Pannu* and *Clement* decisions.

All of these decisions, with the exception of *Byers* and *Riley*, were specifically discussed by the Board in its decision. The *Byers* and *Riley* cases were cited and discussed in the *Ball* decision, upon which the Board relied and, as was explained above, the *Ball* court explicitly declined to follow *Riley*. The examiner has not presented any authority which has not already been fully treated in the Board's decision and, therefore, it is submitted that there is no need for a rehearing by the Board.

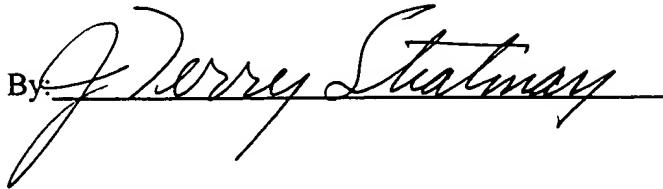
**III.   Conclusions**

The *Ball* case is controlling in the present case. It is directly on point, was properly relied upon by the Board in its decision, remains good law, and the examiner has shown no reason whatsoever to question the authority of the *Ball* case. The examiner's contention that an attempt in reissue to eliminate a claim limitation which was added to the patent claim to obtain its allowance, should, without more, constitute a recapture which bars the reissue claim, irrespective of any other limitations in the reissue claim, was explicitly rejected by the court in *Ball*. All of the authorities cited by the examiner are factually distinguishable from the present case and all that involve reissue have been fully treated in the Board's decision, or in the *Ball* opinion.

Accordingly, the request for rehearing should be denied, or, if it is granted, the Board decision should be adhered to.

Respectfully submitted,

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